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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,364	11/17/2003	Ashok Mehan	MP1725-US2	6674

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Tyco Electronics Corporation
Intellectual Property Law Dept.
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EXAMINER

YAO, SAMCHUAN CUA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/716,364	Applicant(s) MEHAN ET AL.	
	Examiner Sam Chuan C. Yao	Art Unit 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-35,38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-31,34,35,38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11-17-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 14-31, 34-35 and 38-39, drawn to a method of forming a lamp assembly, classified in class 156, subclass 79.
 - II. Claims 32-33. drawn to a non-pressure sensitive foamable composition, classified in class 525, subclass 330.3.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as using the foamable EVA adhesive for bonding a bath-liner to a bathtub.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Ms Marguerite Gerstner on 10-24-05 a provisional election was made **with** traverse to prosecute the invention of Group I, claims 14-31, 34-35 and 38-39. Affirmation of this election must be made by applicant

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in replying to this Office action. Claims 32-33 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

6. The references cited by Applicant on the 1449's have been made of record.

While the statements filed clearly do not comply with the guidelines set forth in MPEP 2004 regarding both the number of references cited and elimination of clearly irrelevant art and marginally pertinent cumulative information, compliance with these guidelines is not mandatory. Furthermore, 37 CFR 1.97 and 1.98 do not require that the information be material, rather they allow for submission of information regardless of its pertinence to the claimed invention. Also, there is no requirement to explain the materiality of submitted references, however, the cloaking of a clearly relevant reference by inclusion in a long list of citations may not comply with Applicant's duty of disclosure, see *Penn Yan Boats, Inc. v. Sea Lark Boats Inc.*, 359 F. Supp. 948, *aff'd* 479 F. 2d. 1338.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14-15 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the current state of art as evidence from anyone of JP 59-121764 and DE 1958307 A in view of Klein (US 4,456,784).

It is a current state of the art to form a lamp assembly from a light emitting glass lamp having an end and a base by securing the end into the base using a foamable material as exemplified in the teachings of JP '764 (abstract; figures 1-2) and DE '307 (abstract; figure). While it is unclear how a foamable material is applied to secure the end into the base, it is recognized and understood that, a foamable material must have to be applied onto a surface of a base and/or a surface of an end of a glass lamp in order to secure them together. In any event, such would have been an obvious in the art as such is a convenient way to apply foamable material between a base and an end of a glass lamp. None, but only the expected result of providing a foamable composition between surfaces of a base and an end of a glass lamp in order to secure them together would have been achieved.

The process of the current state (hereinafter simply referred to as the current process of the art differs from claims 14 or 15 in that, the current process does not teach using copolymeric resins (e.g. ethylene vinyl acetate) recited in these claims. However, it is old in the art to provide a foamable EVA composition in a chamber of a connector, the connector includes electrical conductors extending through the chamber, wherein an expanded EVA composition fills the chamber to provide barrier against vapors as exemplified in the teachings of Klein (col. 2 line 46 to col. 3 line 38 figures 1-2). Since the expanded EVA barrier in a chamber is

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contiguous to electrical conductors, this would have reasonably suggested to one in the art that a foamable EVA material can successfully be applied to an article where it is exposed to a prolong exposure of elevated temperature such as a process of making a lamp assembly where a base and an end of a glass lamp are secured together with a foamable material. For this reason, absent any showing of unexpected benefit, it would have been obvious in the art to use a foamable EVA for securing a base and an end of a glass lamp together. It is worth-noting that a foamable EVA adhesive/sealant is well known in the art.

With respect to claims 20-24, it is a notoriously to form a foamable resin by incorporating microencapsulated blowing agent into a resin matrix. Moreover, the recited amount of blowing agent is a typical amount which is conventional applied to a resin matrix in forming a foamable material. For these reasons, these claims would have been obvious in the art.

9. Claims 16-19, 24-31, 33-35, and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references set forth in numbered paragraph 8 and further in view of Chang et al (US 5,979,902).

The recited materials, compositions and activation temperature range recited in claims 16-19, 24-31, 34-35 and 38-39 are well known in the art of making an expandable EVA sealant composition as exemplified in the teachings of Chang et al (abstract; col. 2 lines 39-51; col. 4 line 3 to col. 7 line 65 and particularly example 1). Absent any showing of unexpected benefit, one in the art would have determined, by routine experimentation, a suitable composition and

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operating condition in forming a foamable EVA sealant/adhesive for a desired end-use of the foamable EVA sealant/adhesive.

With respect to claim 33, a polyamide is a well known tackifier in the art where its main characteristic is high tack property when hot.


Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
11-07-05